

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Guy A. Rouleau *et al.*

Serial No.: 10/664,603

Filed: September 17, 2003

For: LOCI FOR IDIOPATHIC GENERALIZED
EPILEPSY, MUTATIONS THEREOF
AND METHOD USING SAME TO
ASSESS, DIAGNOSE, PROGNOSIS OR
TREAT EPILEPSY

Group Art Unit: 1639

Examiner: Liu, Sue Xu

Atty. Dkt. No.: GOUD:023USD1

Confirmation No.: 3929

CERTIFICATE OF ELECTRONIC TRANSMISSION	
I hereby certify that this correspondence is being electronically filed with the United States Patent and Trademark Office via EFS-Web on the date below:	
April 27, 2007	Date
Michael R. Krawzienek	

SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

In compliance with the duty of disclosure under 37 C.F.R. § 1.56, it is respectfully requested that this Supplemental Information Disclosure Statement be entered and the document listed on attached Form PTO-1449 be considered by the Examiner and made of record. A copy of the listed document required by 37 C.F.R. § 1.98(a)(2) is enclosed for the convenience of the Examiner.

The submitted document is a Decision of a Delegate of the Commissioner of Patents (“Decision”) that issued on January 29, 2007, from the Australian Patent Office in corresponding Australian Patent Application No. 18465/01. The Decision concludes that a Professor Samuel Berkovic is a co-inventor of the invention currently being claimed in the Australian Patent Application. The standard used by the Australian Patent Office to reach its conclusion was whether Professor Berkovic had a “material effect on the invention.” Decision at page 1. Applicants disagree with the Decision.

Applicants believe that the inventorship in the current U.S. application is correct under U.S. law and, therefore, will not seek to add Professor Berkovic as a co-inventor. It is noted that the standard used by the Australian Patent Office to reach its conclusion (*i.e.*, “material effect on the invention”) is not the standard that is used in the U.S. for establishing inventorship. MPEP § 2137.01[II] (“The definition for inventorship can be simply stated: ‘The threshold question in determining inventorship is who conceived the invention. Unless a person contributes to the conception of the invention, he is not an inventor.’”) (quoting *Fiers v. Revel*, 984 F.2d 1164, 1168 (Fed. Cir. 1993)).

In accordance with 37 C.F.R. §§ 1.97(g), (h), this Supplemental Information Disclosure Statement is not to be construed as a representation that a search has been made, and is not to be construed to be an admission that the information cited is, or is considered to be, material to patentability as defined in 37 C.F.R. § 1.56(b).

In accordance with 37 C.F.R. § 1.97(e)(1), Applicants hereby certify that each item of information contained in this Supplemental Information Disclosure Statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more

than three months prior to the filing of the present statement, as evidenced by the date of submitted reference.

No fees are believed to be due in connection with the filing of this Supplemental Information Disclosure Statement, however, should any fees under 37 C.F.R. §§ 1.16 to 1.21 be deemed necessary for any reason relating to these materials, the Commissioner is authorized to deduct the appropriate fees from Fulbright & Jaworski Deposit Account No.: 50-1212/GOUD:023USD1.

Applicants respectfully request that the listed document be made of record in the present case.

Respectfully submitted,
Michael R. Krawzsenek
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Attorney for Applicants

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Date: April 27, 2007

Form PTO-1449 (modified)		Atty. Docket No.: GOUD:023USD1	Serial No.: 10/664,603
List of Patents and Publications for Applicant's INFORMATION DISCLOSURE STATEMENT (Use several sheets if necessary)		Applicant: Guy A. Rouleau <i>et al.</i>	
		Filing Date: September 17, 2003	Group: 1639
U.S. Patent Documents <i>See Page 1</i>	Foreign Patent Documents <i>See Page 1</i>	Other Art <i>See Page 1</i>	

U.S. Patent Documents

Exam. Init.	Ref. Des.	Document Number	Date	Name	Class	Sub Class	Filing Date of App.

Foreign Patent Documents

Exam. Init.	Ref. Des.	Document Number	Date	Country	Language

Other Art (Including Author, Title, Date Pertinent Pages, Etc.)

Exam. Init.	Ref. Des.	Citation
	C82	"Decision of A Delegate of the Commissioner of Patents," issued in Australian Patent Application No. 18465/01, entitled 'Loci for idiopathic generalised epilepsy, mutations thereof and method using same to assess, diagnose, prognose or treatepilepsy,' dated January 29, 2007.

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EXAMINER:	DATE CONSIDERED:
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EXAMINER: INITIAL IF REFERENCE CONSIDERED, WHETHER OR NOT CITATION IS IN CONFORMANCE WITH MPEP609; DRAW LINE THROUGH CITATION IF NOT IN CONFORMANCE AND NOT CONSIDERED. INCLUDE COPY OF THIS FORM WITH NEXT COMMUNICATION TO APPLICANT.